

RESPONSE AND REMARKS

OBJECTION TO DECLARATIONS IN SUPPORT OF IDS

In the Amendment and Response to the previous Office Action for the present application, it was noted that two references on a previously filed FORM PTO-1449, each identified as a separate Declaration by JOHN DIETZ, had each been lined-out on a copy of the FORM PTO-1449 returned with that previous Office Action; no reason had been given for lining out the references. In the Amendment and Response to the previous Office Action, it was respectfully requested that the references be initialed and that an initialed copy of the PTO FORM 1449 be provided with the next Office communication.

In reply to that request, the present Office Action states that "submission of declarations in an IDS is considered to be improper", citing MPEP 715, 716 and 718 for proper procedures for filing a declaration. Office Action, page 6, paragraph numbered 6 under section entitled "Response to Arguments."

RESPONSE REMARKS REGARDING OBJECTIONS TO DECLARATIONS IN SUPPORT OF IDS

The objections to the Declarations by JOHN DIETZ have been carefully considered. It is respectfully submitted that the subject Declarations by JOHN DIETZ were not filed to swear behind a reference (MPEP §715; 37 C.F.R. §1.131), to traverse rejections (MPEP §716; 37 C.F.R. §1.132), or to disqualify commonly owned patent(s) or prior art MPEP §718; 37 C.F.R. §1.130).

Rather, it is respectfully submitted that, further to the duty of disclosure, candor and good faith, as required under 37 C.F.R. §1.56, the Declarations by JOHN DIETZ were filed to disclose events that could be considered material to patentability. The Manual of Patent Examining Procedure specifically recommends "... submit[ting] information about prior uses and sales, even if it appears that they may have been experimental, not involve the specifically claimed invention, or not encompass a completed invention." MPEP §2004. Although the MPEP emphasizes that disclosure must be in writing, there is no

exact prescription for making such a disclosure. See, e.g., MPEP §2002.02. The events disclosed in the Declarations involved facts to which John Dietz declared he had personal knowledge. Accordingly, it is respectfully submitted that it was proper to submit Declarations by JOHN DIETZ as to such facts in support of an Information Disclosure Statement.

It is respectfully requested that the Examiner consider those two references and provide an initialed copy of the PTO FORM 1449 with the next Office communication.

CLAIM REJECTIONS UNDER SECTIONS 102(e) AND 103(a)

In the Office Action, Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124 and 136-141 were rejected under 35 U.S.C. §102(e) as being anticipated by Schwab et al. (U.S. Patent Application Publication No. U.S. 2002/0019777; "Schwab").

Claims 10-12, 27, 48-50, 65, 86-88, 103, and 124-126 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab in view of Kara (U.S. Patent No. 6,233,568; "Kara").

Claims 13-21, 27, 51-59, 65, 89-97, and 127-135 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab and Kara as applied to Claims 11, 49, 87, and 125 and further in view of UPS® Service Guide (www.ups.com) ("UPS"), FedEx® Services (www.fedex.com) ("FedEx") and Barnett et al. (U.S. Patent No. 6,369,840; "Barnett").

Claims 19-21, 57-59, 95-97 and 133-135 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab and Kara, and further in view of Siegel (U.S. Patent Application Publication No. U.S. 2004/0143519; "Siegel").

RESPONSE REMARKS TO CLAIM REJECTIONS UNDER SECTIONS 102(e) AND 103(a)

The rejections of the Claims have been carefully considered. Claims 1, 22, 24, 27, 39, 40, 60, 62, 65, 77, 98, 100, 103, 115, 136, 138, 139 and 141 have been amended. It is respectfully submitted, for the reasons given below, that the

amended Claims, and the claims dependent on them, are in condition for allowance.

Regarding the Rejection of Claims 19-21, 57-59, 95-97 and 133-135 in view of the Siegel Reference

With regard to the citation of Siegel as a basis for rejecting Claims 19-21, 57-59, 95-97 and 133-135 under 35 U.S.C. §103(a), it is respectfully submitted that the earliest priority date of the Siegel reference (March 26, 2001) does not precede the priority date (March 28, 2000) of the earliest-filed provisional application (U.S. Provisional Application No. 60/192,692; the "'692 Application") to which the present application claims priority. Further, it is respectfully submitted, for the reasons described below, that the '692 Application disclosed all of the features for which Siegel is cited in the Office Action and supports the subject matter of the claims rejected in view of Siegel.

In rejecting Claims 19, 20, 57, 58, 95, 96, 133, and 134, the Office Action cited the abstract of Siegel as "disclos[ing] the use of an online merchandise return system, which prints labels for returns ...". Office Action, p. 5, Topic Number 4.

Claims 19, 57, 95, and 133 all recite "...generat[ing] a set of printable shipping label data in response to a shipping label print request by the consumer." Claims 20, 58, 96, and 134 all recite "... send[ing] in response to a user request to print a shipping label the set of printable shipping label data to a printer connected to the computer accessible by the user."

It is respectfully submitted that the '692 Application disclosed "... print[ing] a return shipping label on a printer attached to the customer's personal computer ...". '692 Application, p. 5, lines 10-12; see also, e.g., '692 Application, p. 32, lines 7-9; '692 Application, p. 32, line 10 – p. 36, line 20.

The Office Action cited Figures 1A and 5 and "corresponding detailed descriptions" of Siegel as disclosing the subject matter of Claims 21, 59, 97, and 135. Office Action, p. 6, Topic Number 14.

Claims 21, 59, 97, and 135 all recite "...generat[ing] a tracking report record depicting the shipping status of a return order in response to a user tracking report request for said return order."

It is respectfully submitted that the '692 Application' disclosed "...provid[ing] each participating Merchant with tracking capabilities for returned parcels." '692 Application', p. 5, lines 34-35; see also, '692 Application', p. 59, line 1 – p. 60, line 36. Further, the '692 Application' disclosed that "[o]nce the Consumer has shipped a return package, the Consumer can track the shipment through the Merchant's online store." '692 Application', p. 58, lines 14-15; see also, '692 Application', p. 55, lines 15-34.

In view of the above-outlined support by the '692 Application', the filing date of which precedes the earliest priority date of Siegel reference, it is therefore respectfully submitted that Claims 19-21, 57-59, 95-97 and 133-135 under 35 U.S.C. §103(a) are in condition for allowance.

Regarding the Rejection of Claims as anticipated by, or as unpatentable over, the Schwab Reference

Schwab discloses a system by which a "third party establishment (agent) acts as an agent to an e-commerce or catalog merchant (merchant) ... [for] process[ing] product returns for that merchant." Schwab, Abstract. Schwab discloses a merchant sending a document, referred to in Schwab as a "ReturnCERT 501", with a product ordered by a consumer when the product is shipped to the consumer. Schwab, Paragraph 0051. Paragraph 0052 of Schwab discloses that:

Should the consumer 20 then wish to return the product 503, he can present the ReturnCERT 501 to a local third party 60. The third party 60 would then scan, using scanner 601 or in some other fashion interpret the ReturnCERT 501, as may be suitable or known to those skilled in the art, and link or enter the ReturnCERT 501 data into his computer system 603.

As compared to a consumer having to present a document to a local return agent as disclosed in Schwab, Claim 77, for example, of the present

application is directed to a computer product for online merchandise return shipping having instructions for:

receiving by an online merchandise return computer system a merchandise return request by a consumer to return at least one item of merchandise, wherein said merchandise return request is input by the consumer via a client computer, wherein said consumer is a user of the online merchandise return computer system ...

See *also*, Claims 39 and 115. It is respectfully submitted that the above-cited recitation by Claim 77 (and Claims 39 and 115) that a merchandise return request is input by a consumer via a client computer is patentably distinguished from the above-cited disclosure of Schwab of a consumer presenting a document to a local agent for the agent's entry into a system. It is respectfully submitted that the disclosure of Schwab of a consumer presenting a document to a local agent for the agent's entry into a system would not provide a consumer with the ability to input a merchandise return request from a client computer, such as the consumer's own computer. Therefore, it is respectfully submitted that various embodiments of Claims 77, 39 and 115 would be useful over the cited references in allowing a consumer to input a merchandise return request from a client computer, such as the consumer's own computer.

Further, it is respectfully submitted that neither Schwab, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation of Claim 77 (and Claims 22 and 98) "...wherein the merchandise return request comprises an indication of at least one item of merchandise in a list of a plurality of items of merchandise that the consumer purchased from the merchant using an online computer system...". See *also*, Claims 115, 136, and 138 (reciting "...wherein the merchandise return request comprises an indication of an item on the list of items..."); Claim 1 (reciting "...wherein the merchandise return request comprises a designation of a particular respective interactive means associated with a particular respective item of merchandise identified in the purchase identification...").

Yet further, it is respectfully submitted that neither Schwab, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation of Claim 24 to "... collect a set of return policy rules input by a merchant, wherein the set of return policy rules comprises general return policy rules and at least one exception policy rule...". See also, e.g., Claim 100 (reciting "...generating a graphic user interface for input of return policy rules, wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules...").

Still further, it is respectfully submitted that neither Schwab, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation of Claim 27 (and Claim 103) "...wherein the set of carriers and the set of services are selected by the computer system for display according to a set of return policy rules input by the merchant ...". See also, e.g., Claim 141 (reciting "...wherein the set of carriers and the set of delivery services are selected according to a set of return policy rules previously input by the merchant ..."); Claim 65 (reciting "...said carriers and services selected by the computer system for display according to a set of return policy rules input by a merchant...").

Further still, it is respectfully submitted that neither Schwab, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation of Claim 39 (and, e.g, Claims 60, 62, 65, and 98) "... wherein a subset of the return policy rules input by the merchant comprises: a set of return questions; and a set of anticipated return question responses corresponding to each of said return questions...".

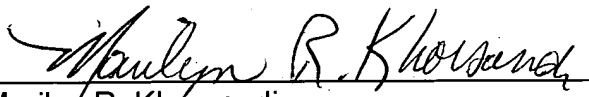
CONCLUSION

For the reasons given above, in view of the amended Claims, it is respectfully submitted that the invention disclosed and claimed in the present amended application is not fairly taught by any of the prior art references of record, taken either alone or in combination, and that the application, as

amended, is in condition for allowance. Accordingly, it is respectfully requested that the claims of the present application be reconsidered and allowed.

Respectfully submitted,

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